## THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ROSS M. SWAN

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Appeal No. 98-2186 Application No.  $08/517,946^{1}$ 

ON BRIEF

Before MEISTER, FRANKFORT, and PATE, <u>Administrative Patent</u> Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

 $<sup>^{\</sup>scriptscriptstyle 1}$  Application for patent filed August 22, 1995.

This is a decision on appeal from the examiner's final rejection of claims 1 through 15, which are all of the claims pending in this application.

Appellant's invention relates to an apparatus and method for conditioning air within the enclosed space of a building. Independent claims 1 and 9 are representative of the subject matter on appeal and a copy of those claims may be found in the Appendix to appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Watkins	3,173,353	Mar. 16,
1965		
Sassmann	4,292,927	Oct. 6,
1981		
Lestage	5,092,520	Mar. 3,
1992		

An additional prior art reference of record in the present application relied upon by this panel of the Board in a new ground of rejection entered pursuant to 37 CFR § 1.196(b) is:

Bobjer et al. (Bobjer) 4,515,070 May 7,

Claims 1 through 5 and 8 through 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lestage in view of Watkins.

Claims 6, 7, 14 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lestage in view of Watkins as applied above, and further in view of Sassmann.

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the final rejection (Paper No. 7, mailed December 4, 1996) and the examiner's answer (Paper No. 11, mailed December 2, 1997) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 10, filed November 6, 1997) and reply brief (Paper No. 12, filed February 5, 1998) for appellant's arguments thereagainst.

## OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review we have reached the determinations which follow.

Looking to the examiner's prior art rejection of appealed claims 1 through 5 and 8 through 13 under 35 U.S.C. § 103 as being unpatentable over Lestage in view of Watkins, we note that as has been set forth on pages 2-3 appellant's specification, the Lestage patent discloses an air extraction apparatus for dehumidifying air in a basement or other enclosed area of a building. The Lestage apparatus is very similar to that defined in independent claim 1 on appeal, with the exception that the fan (8) of Lestage is seen to be at the outlet end of conduit (6) instead of being located "adjacent the bottom floor" as required in appellant's claims on appeal. In accordance with appellant's drawings and the disclosure at

page 5, lines 5-19, of the specification, we understand the language "adjacent the bottom floor" in claim 1, and similar language in method claim 9, to require that the fan (42, 46) be located at the inlet end (50) of a discharge conduit (e.g., 44) and closely adjacent the floor of the bottom level of a building, usually the basement floor as seen at (14) in appellant's Figure 1.

Recognizing the above-noted deficiency in Lestage, the examiner turns to the heat retrieving device of Watkins, noting that this device has the fan or pump (28) thereof located adjacent the floor (12). The examiner concludes that it would have been obvious to one of ordinary skill in the art to move the fan (8) of Lestage so that it is located adjacent the floor (1) therein, in view of Watkins, for the purpose of making it easier to remove the fan for cleaning or repair purposes.

In our opinion, the examiner's rejection is merely an improper hindsight attempt to reconfigure and reconstruct the device of Lestage based on appellant's own teachings and not

on any fair teachings or suggestions found in Lestage and Watkins. Like appellant, we note that both Lestage and Watkins teach or suggest that the fan or pump member of the respective systems therein be located at the discharge end of the associated conduit (6 of Lestage and 16 of Watkins) instead of being "connected to said air inlet end of said conduit means" as required in claim 1 on appeal and "adjacent the [or a] bottom floor" so as to remove air at the floor level and discharge the air through the associated conduit to the exterior of the building, as set forth in both claims 1 and 9 on appeal. As a further point, we observe with regard to this rejection that the examiner has made no attempt at all to address the limitations of claims 5, 8 and 13 on appeal. these reasons, we will not sustain the examiner's rejection of claims 1 through 5 and 8 through 13 on appeal under 35 U.S.C. § 103.

With regard to the examiner's rejection of claims 6, 7, 14 and 15 under 35 U.S.C. § 103 based on Lestage, Watkins and Sassmann, we share appellant's view as expressed on pages 9 and 10 of the brief, and again conclude that the examiner's

proposed combination of these patents is completely unsupported by the teachings of the references themselves and is based on

impermissible hindsight derived solely from appellant's own disclosure. For that reason, the examiner's rejection of these claims under 35 U.S.C. § 103 will likewise not be sustained.

As is apparent from the foregoing, the decision of the examiner rejecting claims 1 through 15 of the present application is reversed.

Pursuant to our authority under 37 CFR § 1.196(b), we enter the following new ground of rejection against appellant's claims 1 through 3 and 9 through 12 on appeal.

Claims 1 through 3 and 9 through 12 are rejected under 35 U.S.C. § 103 as being unpatentable over Bobjer. In our opinion, it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to have utilized the ventilation device of Bobjer on a bottom or basement floor of a building to condition the air within an enclosed space during the painting of said space (as generally disclosed in Bobjer), or at any other time that an owner may

desire. In this context, we note that the device of Bobjer includes a conduit means (14) and a fan means (9) mounted on or adjacent the floor (3) of an enclosed space within the building and connected to an air inlet end of the conduit means (14) for removing air from the floor level and discharging the air through the conduit means and a wall opening (5) to the exterior of the building. With particular regard to the requirement of claim 12 on appeal, we are of the view that operating the fan of Bobjer in an enclosed space on the bottom or basement floor of a building would inherently "regulate humidity in the enclosed space" by drawing the relatively heavy humid air near the floor out through the conduit means (14) and allowing less humid air from adjacent the ceiling (2) to replace it.

With respect to appellant's evidence of commercial success, we note that the items supplied by appellant appear to present

merely laudatory comments about the invention, or the general concept of the invention, with little factual information being provided. While such praise of the invention may well

lead appellant to the conclusion that the Dehumid "Mother's Helper" or other Dehumid units are destined to enjoy commercial success, these expectations by appellant do not provide any substantial evidence which can be said to outweigh the evidence of obviousness relied upon by this panel of the Board in our new ground of rejection above. While we may accept appellant's personal view, and that expressed in the letters, that the invention is meritorious, we cannot conclude that such

recognition alone forms any basis to overcome the strong evidence of obviousness that we have relied upon above in the form of the Bobjer patent.

One major area of weakness in appellant's evidence is the lack of any indication that the various units referred to in the letters are in fact like the apparatus set forth in the claims before us on appeal. Where it is asserted that commercial success of the invention supports a conclusion of nonobviousness, the appellant is required to demonstrate a nexus between the merits of the claimed invention and the evidence of commercial success. See Cable Electric Products, Inc. v. Genmark, Inc., 770 F.2d 1015, 1027, 226 USPQ 881, 888 (Fed. Cir. 1985). No such nexus has been established by the "evidence" presented by appellant in the present case. Moreover, we also observe that no evidence is offered as to other factors of significance in establishing commercial success, such as total market demand, market share, growth of market share or the extent to which appellant's air conditioning assembly has displaced other assemblies in the market. Nor is there evidence to show that sales of

appellant's units were due to the claimed features of the invention and not to other factors like preferential pricing relative to competing products and substantial advertising.

In view of the foregoing, we are satisfied that when all the evidence is considered, the totality of the evidence submitted by appellant cannot be accorded substantial weight, so that, on balance, the evidence of nonobviousness fails to outweigh the evidence of obviousness relied upon by this panel of the Board in our new ground of rejection.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

§ 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant,

WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise

one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . .
- (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR  $\S$  1.136 (a).

## REVERSED; 37 CFR § 1.196(b)

JAMES M. MEISTER	)			
Administrative Patent Judge	)			
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	)	BOARD	OF	PATENT
CHARLES E. FRANKFORT	)	APPEALS		
Administrative Patent Judge	)	) AND		)
	) INTERFERENCES			RENCES

WILLIAM F. PATE
Administrative Patent Judge

CEF/sld

Hodgson, Russ, Andrews, Woods & Goodyear Intellectual Property Practice Group 180 One M & T Plaza Buffalo, NY 14203-2391

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Appeal No. 98-2186 Application No. 08/517,946

**APJ FRANKFORT** 

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**REVERSED** 

Prepared: March 20, 2000